

### **Remarks**

Claims 1-25 are currently pending in the subject application. Claims 1, 12 and 23 have been amended herein. Claim 25 has been newly added. A clean version of pending claims is found at pages 2-5. A marked-up version showing amendments made herein is found at page 9. Favorable reconsideration of the subject application is respectfully requested in view of the comments below.

#### **I. Rejection of Claims 1-24 Under 35 U.S.C. §112**

Claims 1-24 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Reconsideration and withdrawal of this rejection is respectfully requested for at least the following reasons.

Claims 1 and 12 have been amended herein to include periods at their conclusion in accordance with the Examiner's comments. Claim 23 has been amended to remove the term "adapted". These claim amendments have been made for clarification purposes only and are not intended to narrow the scope of the respective claims.

Accordingly, this rejection should be withdrawn.

#### **II. Rejection of Claims 1-24 Under 35 U.S.C. §103(a)**

Claims 1-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Emori, *et al.* or Root, *et al.* Reconsideration and withdrawal of this rejection is respectfully requested for at least the following reasons.

Emori discloses an electric apparatus having a plurality of electrical parts and a casing made of electrically conductive material. The casing is provided with a plurality of projections for radiating heat. Root discloses a heat dissipator apparatus for a transistor.

The crux of the Office Action's arguments supporting rejection of claims 1-24 is that "it is well known to make integral that which was separate." The Office Action is misinterpreting the case law and drawing erroneous conclusions. The Court in *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) held that "the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure, showing insight that was contrary to the understandings

and expectations of the art.” Thus, the Office Action’s broad statement that “it is well known to make integral that which is separate” is overreaching and incorrect.

Additionally, the Office Action cites Applicant’s background as admitting that it is well known to monitor machines in general. Applicant’s claims are not limited to simply monitoring motors. In the background, Applicant does describe the use of portable recorders to collect data relevant to the machine’s health and also describes the problems associated with using a data recorder, reproducing the precise location of the data sensed and using manpower to collect the data. However, Applicant disagrees with the Examiner’s assertion that Applicant’s claims merely cover attaching a portable recorder to a motor.

It is respectfully submitted that Emori and Root, alone or in combination, fail to teach or suggest all of the claim elements of claims 1-24.

For example, claim 1 includes a machine diagnostic system, which is not taught, alone or in combination, by the cited references. Additionally, claim 1 includes a heat dissipation device which dissipates heat generated by the machine which is not taught, alone or in combination, by the cited references. Claims 2-22 depend from claim 1 and include the claim elements of claim 1.

Claim 23 includes a diagnostic module and a heat dissipation device “which includes a first set of fins, at least one of the fins having a base which engages an outer mounting surface of the machine” which are not taught by Emori and Root, alone or in combination.

Claim 24 includes containing the diagnostic module and “employing a plurality of fins ...wherein at least one of the fins has a base which engages the outer mounting surface of the machine” which are not taught by the cited references.

Additionally, the Office Action fails to show a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Emori and Root operate to dissipate heat generated from electrical components such as invertors and transistors. Emori and Root do not mention and are not applicable to dissipating heat from a machine. The Office Action has not met its burden in establishing a prima facie case of obviousness.

Accordingly, this rejection should be withdrawn.



### III. Conclusion

The present application is believed to be condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

In the event any additional fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Himanshu S. Amin".

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**In the Claims:**

Please amend claims 1, 12 and 23 and add new claim 25 as indicated below.

1. (Amended) In combination, a dynamoelectric machine and a machine diagnostic system for on-line diagnosis of the machine;

the machine diagnostic system comprising a machine diagnostic module which collects data relating to operation of the machine and a package which is mounted to an outer mounting surface of the machine; and

the package comprising a container which contains the machine diagnostic module and a heat dissipation device, positioned between the container and the outer mounting surface of the machine, which dissipates heat generated by the machine into surrounding air thereby minimizing heat transfer to the container.

12. (Amended) The combination set forth in claim 11, wherein the container and the heat dissipation device are made of at least one of: cast iron, diecast aluminum, extruded aluminum, machined aluminum, and thermally conductive plastic.

23. (Amended) A package for a diagnostic module of a dynamoelectric machine comprising:  
a container [adapted] to contain the diagnostic module; and a heat dissipation device which includes a first set of fins, at least one of the fins having a base which engages an outer mounting surface of the machine and a tip which engages the container whereby heat is conducted through the base towards the tip and is transferred by convection into the surrounding air.

-- 25. (New) The combination set forth in claim 1 further comprising:  
a network backbone connected to the machine diagnostic module; and  
a host computer connected to the network backbone able to receive diagnostic data provided from the machine diagnostic module and to allow on-line diagnosis of the machine. --